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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/072,599

02/05/2002

Robert H. Dahla

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04/20/2006

ARTHROCARE CORPORATION
680 VAQUEROS AVENUE
SUNNYVALE, CA 94085-3523

EXAMINER

HAYES, MICHAEL J

ART UNIT

PAPER NUMBER

3767

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,599

Applicant(s)

DAHLA ET AL.

Examiner

Michael J. Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-22 and 25-88 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15-24, 26, 28-36 and 38-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14, 25, 27, 37 and 83-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/05/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of group I and species 10 drawn to fig. 16B in the reply filed on 10/22/04 is acknowledged.

Claims 13, 15-22, 28-36, and 38-82 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/22/04.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 6, 8, 27, 83, 84, 85, 87, and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over RYDELL (US Patent No. 5,047,027) and GOBLE (US Patent No. 6,013,076). Rydell discloses an electrosurgical probe including a return electrode coil 28, and active electrode 30 within a lumen of the return coil. The return electrode coil has more than 6 turns, is parallel to the longitudinal axis of return electrode filament, the first turn is at the distal end (whether the first turn is considered at the distal or proximal end is merely a matter of whether counting starts at the distal or proximal end), and an insulating spacer 46 is proximal to the electrode head (See figs. 1, 2; col. 3, ll. 1-45). The spacer is surrounded by the return

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electrode. The active electrode head is seen as the tip of the active electrode filament and is configured as a flattened disc or plane perpendicular to the coil axis. Rydell does not disclose an electrically conductive fluid delivery element adapted to deliver fluid or a suction lumen. Goble '076 discloses an electrically conductive fluid delivery element adapted to deliver fluid and a suction lumen (col. 3, line 64 - col. 4, line 60; col. 9, line 62 - col. 10, line 13). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Goble '076 in the device of Rydell in order to treat tissue with electrically-conductive fluid to remove tissue by vaporization (see Goble '076, col. 3, ll. 25-35).

Claims 4, 5, 9, 10, 11, 14, 25, 27, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over RYDELL and GOBLE '076 in view of GOBLE (US Patent No. 5,891,134) and/or RYAN (US Patent No. 6,280,441). Rydell and Goble '076 disclose the claimed invention as discussed above except for the helix pitch of 0.01-0.045in., electrode coil external diameter 0.07-0.2 in., return electrode filament diameter 0.008-0.03 in., active electrode filament diameter 0.006-0.02 in., ceramic insulating spacer, and handle housing the connection block. Goble '134 teaches the use of a ceramic insulating spacer and handle housing the connection block. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Goble '134 in the probe of Rydell and Goble '076 in order to use a well-know material for insulation and to obtain an efficient device that is easy to use by having the handle house the connection. With respect to claims 4, 5, 9, 14 it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the probe disclosed by Rydell and Goble '076 to the claimed dimensions because Applicant has not stated that these dimensions are for a stated purpose or to solve a particular problem and it appears other dimensions would work

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equally as well. Applicant has not supplied any criticality with respect to these dimensions and they are merely design choice. With respect to claim 10 Ryan teaches the use of gaps between turns. The spacing of the gaps is capable of retaining liquid against coil surfaces. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Ryan in the invention of Rydell and Goble '076 to obtain spaced coils that can be easily attached to tissue.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over RYDELL and GOBLE '076 in view of COHEN (US Patent No. 4,832,048). Rydell and Goble '076 disclose the claimed invention except for making the electrodes of titanium. Cohen teaches to use these materials for insulation and for the electrodes. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Cohen in the probe of Rydell and Goble '076 in order to make an electrosurgical probe using common, well-known materials for insulation and electrodes.

Allowable Subject Matter

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Hayes at (571) 272-4959. The examiner can usually be reached Monday -Thursday, 7:00-4:30, and on alternate Fridays. The fax number for submitting official papers is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjh

17 April 2006

A handwritten signature in black ink, appearing to read "M. J. Hayes", with a stylized flourish at the end.

MICHAEL J. HAYES
PRIMARY EXAMINER